Remarks

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-16 are presently pending before the Office. Applicants have amended claims 5, 8, 11, and 12. Claim 9 has been canceled. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed. Applicants are not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed January 11, 2006, and the references cited therein, have been carefully studied by Applicants and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, it is believed this patent application is in a condition for allowance.

The Examiner rejected claims 8 and 12 under 37 C.F.R. §1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only.

Applicants' amendment herein clarifies the intended language and refers to the other claims in the alternative only.

Applicants request reconsideration and withdrawal of the objection.

Relying on 35 U.S.C. §102, the Examiner has rejected claims 1-4, 6 and 13 as being anticipated by Popescu. Applicants respectfully traverse the rejection and request reconsideration.

It is evident Applicants' invention is decidedly different from the teachings of the cited patent.

The Popescu reference requires a moisture sensitive product (column 1, line 11) in a closed sterilization system to be sterilized in an unsealed moisture impervious package (column 1, line 26) and while transferring said package containing the product until the product is substantially free of

detectable moisture, that will then seal the package (column 7, line 30 to 35).

No precise method of monitoring the moisture content is taught in Popescu.

As noted by the Examiner, the Popescu reference fails to teach or claim evacuating a single chamber [emphasis added] to a pressure of 1 to 3 inches of mercury, and injecting said chamber with warm air.

The Popescu reference requires at least three different vessels each with a different function.

In an alternative embodiment of the present invention, no special chamber is required.

No real-time monitoring of the concentration of the ethylene oxide gas is claimed in the Popescu reference.

If each and every element of the claimed invention is not shown in a single relevant prior art reference, then rejection of the application under Section 102 is improper. See Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698, 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983); See also In re McLaughlin, 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (1971).

Claims 14-16 are rejected under 103(a) as being unpatentable over Popescu et al. (U.S. Patent No. 5,464,580) in view of Vera et al. (U.S. Patent No. 6,440,364) and further in view of Joslyn (U.S. Patent No. 4,770,851).

It is error to reconstruct a patentee's claimed invention from the prior art by using the patentee's claim as a blueprint. W. L. Gore & Associates v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (CAFC 1983).

As Figure 1 notes in the Vera patent (6,440,364), the filtered air step is to be skipped for a single chamber operation; See also column 5, lines 20-25.

Further, while the Joslyn reference suggests the use of warm air, no real-time monitoring of the concentration of ethylene oxide gas in the headspace occurs, and the Joslyn reference requires

repeated flushing of the sterilizing chamber.

The mere fact the prior art could be modified does not make the modification obvious. In re Hashowski, 871 F.2d 115, 10 U.S.P.Q. 2d 1297 (CAFC) 1989.

There must be some supporting teaching in the prior art for the reference combination. In re Newell, 891 F.2d 899, 13 U.S.P.Q. 2d 1248 (CAFC 1989).

Claim 16 incorporates the limitations of both claims 14 and 15.

With respect to claim 11, which is rejected under 35 U.S.C. §103(a) as being unpatentable over Popescu et al. (U.S. Patent No. 5,464,580) in view of Vera et al. (U.S. Patent No. 6,440,364) and Stewart et al. (U.S. Patent No. 5,882,590) as applied to canceled claim 9, and as incorporated into (currently amended) claim 5, and further in view of Kolstad et al. (U.S. Patent No. 4,973,449).

As noted by the Examiner, the Popescu reference, the Vera reference, and the Stewart reference all fail to teach evacuating the chamber down to 3 to 7 inches of mercury (p. 2, line 5) and pulsing the chamber with 5 to 9 inches of heated Nitrogen gas (p. 2, line 5) while the Kolstad reference teaches pulsing by evacuating the chamber down to 3 to 7 inches of mercury and pulsing the chamber with 5 to 9 inches of heated Nitrogen, the Kolstad reference specifically requires said industrial products to be unsaturated with water (column 2, lines 58-68), essentially teaching away from the present invention. See ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577 *n.17., 221 U.S.P.Q. 929, 933 *n14 (Fed. Cir. 1984); See also Lindeman Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984), Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985).

With respect to Paragraph 6, attached as Exhibit A is the Assignment from the joint inventors to the Assignee, IBA S&I, Inc., both inventors were and are employees of the IBAS S&I,

Inc. entity at the time of the invention.

Attached as Exhibits B, C, and D, respectively, are:

(1) Certificate of Amendment of Certificate of Incorporation of IBA S&I, Inc. to Sterigenics EO, Inc.;

(2) Certificate of Merger merging Sterigenics EO, Inc. into Sterigenics S&I Holding Corp.; and

(3) Certificate of Merger of Sterigenics S&I Holding Corp. into Sterigenics U.S., LLC.

The Certificates of Amendment are in the process of being recorded in the U.S. Patent and Trademark Office Assignment Division.

With this Amendment, it is believed the application is in a condition for allowance, and the same is courteously solicited.

Should the Examiner be of the opinion a telephone conference would expedite prosecution of the subject application, he is respectfully requested to call the undersigned at the below-listed number.

Respectfully submitted,

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